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**REMARKS**

**I. General**

The only issues raised by the August 25, 2005 Office Action are:

- Claims 1-6, 13, 14, 23-35, 37, and 39-44 stand rejected under 35 U.S.C. § 102 as being anticipated by Nee, United States Patent Number 6,661,539 (hereinafter *Nee*); and
- Claims 7-10, 40, and 41 stand rejected to under 35 U.S.C. § 103 as being unpatentable over *Nee* in view of Krist, United States Patent Number 5,615,015 (hereinafter *Krist*).

Applicant wishes to thank the Examiner for indicating that claims 11, 12, 15-22, 36, 38, 45, and 46 contain allowable subject matter. However, Applicant respectfully transverses the rejections of the remaining claims. Claims 1-46 remain pending in the present Application.

**II. 35 U.S.C. § 102 Rejections**

Claims 1-6, 13, 14, 23-35, 37, and 36-44 stand rejected as anticipated by *Nee*. However, Applicant respectfully points out that it is well settled that to anticipate a claim, a reference must teach every element of the claim, see M.P.E.P. §2131. Moreover, in order for a reference to be anticipatory under 35 U.S.C. §102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” see M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejections do not satisfy one or more of these requirements, as detailed below. Therefore, Applicant respectfully asserts that claims 1-6, 13, 14, 23-35, 37, and 36-44 are patentable over the 35 U.S.C. § 102 rejections of record.

**A. Independent Claim 1**

Claim 1 recites “a frame defining a display area” (emphasis added). However, *Nee* fails to incorporate a display area into his scanner. The Office Action fails to fully address the display area claim element. Regardless, *Nee* fails to display anything. Col. 4, lines 9-10 of *Nee* explains “covers 102 and 103 conceal scanning surface 201.” Furthermore, outer cover 102 of *Nee* is a stiff, opaque polymeric material. Col. 4, line 50. Accordingly, *Nee* is incapable of displaying anything. Thus, *Nee* cannot be fairly characterized as teaching claim 1 elements “a transparent retention pane...spanning said display area,” “a support back spanning said display area,” or “an image scanning bar ...moving across said display area” either.

Claim 1 further recites “said support back spaced apart from...said retention pane” (emphasis added). *Nee* fails to disclose this element. By way of example, Figure 4 of the current Application shows a top view of the scanner and a clear view of media reception slot 401. Media reception slot 401 is a defined space between support back 301 and retention pane 305 resulting from the support back being spaced apart from the retention plate. See Application paragraph [0019].

*Nee* fails to disclose a “support back spaced apart from...said retention pane.” The Office Action likens transparent cover 103 of *Nee* to the Applicant’s transparent retention pane 305 and outer cover 102 of *Nee* to Applicant’s support back 301. According to *Nee*, the transparent cover 103 is sandwiched between outer cover 102 and the frame, thereby leaving no space between outer cover 102 and transparent cover 103. Col. 4, lines 3-5. Furthermore, Figures 1 and 2 of *Nee* show there is no space between outer cover 102 and transparent cover 103. As a result, *Nee* fails to teach “said support back spaced apart from...said retention pane” as recited by independent claim 1.

Because *Nee* fails to disclose each and every element of claim 1, particularly arranged or in as complete detail as recited in claim 1, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102 rejection of independent claim 1.

**B. Independent Claims 33 and 42**

Independent claim 33 recites “retaining said item within said frame for display” and independent claim 42 recites “an item to be...displayed.” As explained above in addressing the anticipation rejection of claim 1, *Nee* fails to disclose a method or system for displaying an item. As a result, Applicant asserts that *Nee* fails to disclose independent claim 33 element “retaining said item within said frame for display” and independent claim 42 element “an item to be...displayed.” Whereas *Nee* fails to disclose each and every element of claims 33 and 42 in as complete detail as recited in those claims, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102 rejection of independent claims 33 and 42

**C. Dependent Claims 9, 10, 13, 14, 23-32, 34, 35, 37, 39-41, 43, and 44**

Claims 9, 10, 13, 14 and 23-32 ultimately depend from claim 1 and thereby inherit all the elements thereof. Claims 34, 35, 37 and 39-41 each depend directly from independent claim 33 and thereby inherit all the elements thereof. Claims 43, and 44 depend directly from claim 42 and thereby inherit all the elements thereof. Therefore, at least for the reasons advanced above in addressing the anticipation rejections of claims 1, 33 and 42, Applicant respectfully asserts claims 9, 10, 13, 14, 23-32, 34, 35, 37, 39-41, 43, and 44 are also patentable over the 35 U.S.C. § 102 rejections of the record. Moreover, the dependent claims introduce additional features not taught by the prior art.

For example, claim 2 recites “memory storage is located within said picture frame scanner.” The Office Action cites col. 4, lines 5-10 of *Nee* as disclosing this memory. Office Action, page 3. However, the cited lines fail to discuss memory storage. Instead, the cited lines teach “electrical and mechanical components used for scanning images.” Col. 4, lines 5-10. Because *Nee* failed to specifically discuss memory storage located *in* the scanner, *Nee* fails to anticipate claim 2. As a result, Applicant respectfully asserts that claim 2 is still further patentable over the rejection of record.

Claim 6 recites “a stand extending *rearwardly* from lower corner of said frame, said stand...*maintaining* said scanner.” The Office Action cites either feet 302 or feet 111 of *Nee* as teaching this element. However feet 302 and feet 111 fall short of anticipating claim 6. If feet 111 are “maintaining said scanner,” then as shown by Figure 3 of *Nee*, feet 111 are extending *downwardly* from the scanner instead of rearwardly as required by claim 6.

Likewise, if the scanner is rotated and feet 302 are “maintaining said scanner,” then feet 302 are extending *downwardly* from the scanner instead of rearwardly as required by claim 6. Because *Nee* fails to disclose the elements of claim 6, Applicant asserts claim 6 is still further patentable over the 35 U.S.C. § 102 rejection of record.

Claim 39 recites “disposing said item to be scanned in said frame facing outward.” The Office Action cites Figure 2 as disclosing this element. Office Action, page 4. However, Figure 2 fails to show the item to be scanned facing outward. In fact, the item must be facing inward to face the scanning components located behind scanning surface 201. See *Nee* Fig. 2. Therefore, Applicant asserts claim 39 is further patentable over the cited art.

### **III. 35 U.S.C. § 103 Rejections of Claims 7-10, 40, and 41**

Claims 7-10, 40, and 41 stand rejected as being unpatentable over *Nee* in view of *Krist*. However, the suggested combination fails to meet a prima facie case of obviousness.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim elements. See M.P.E.P. § 2143. Therefore, without conceding the first or second criterion, Applicant respectfully asserts that the rejection fails to satisfy the third criteria.

Claims 7-10 ultimately depend from independent claim 1 and thereby inherit all the elements thereof, while claims 40 and 41 depend directly from independent claim 33 and thereby inherit all the elements thereof. As discussed above in addressing the anticipation rejections of claims 1 and 33, *Nee* fails to teach or suggest elements of claims 1 and 33. *Krist* is not relied upon as teaching these elements. Therefore, Applicant respectfully asserts that for this reason alone claims 7-10, 40, and 41 are patentable over the 35 U.S.C. § 103 rejections of the record. Moreover, the dependent claims introduce additional features not taught by the prior art.

For example, claim 7 recites “[t]he picture frame scanner...comprising a rotation selection control.” The Office Action cites *Krist*, column 10, lines 53-63 as teaching this element. Office Action, page 5. However, the cited lines do not teach or suggest the scanner having a selection control. Rather, the cited portion of *Krist* discusses various settings available for formatting an image using software at a network workstation. As a result, Applicant contends claim 7 is further patentable of the 35 U.S.C. § 103 rejection of record.

Claim 8 recites “wherein said rotation on control is a user operative control mounted on said scanner.” The Office Action cites *Krist*, column 10, lines 53-63 as teaching this element. Office Action, page 5. However, the cited lines do not teach or suggest a rotation on control mounted on the scanner rotation. Rather, as the Office Action admits, the cited portion of *Krist* discusses various settings available for formatting an image using software at a network workstation remote from the scanner. As a result, Applicant contends claim 8 is further patentable of the 35 U.S.C. § 103 rejection of record.

Claims 9, 40, and 41 recite a “wireless remote control” and a “wireless device.” The Office Action cites *Krist*, column 10, lines 53-63 as teaching the “wireless device.” Office Action, page 5. However, *Krist* fails to teach or suggest a wireless remote control or a wireless device. As noted above, the cited portion of *Krist* discusses formatting an image using software at a network workstation, no mention is made as to whether this workstation can take the form of a wireless remote control or the like. As a result, Applicant contends claims 9, 40 and 41 are further patentable of the 35 U.S.C. § 103 rejections of record.

Claim 10 recites “sensing an orientation of said frame.” The Office Action cites *Krist*, column 10, lines 53-63 as teaching this element. Office Action, page 5. However, the cited lines do not teach “sensing an orientation of said frame” in any way. Therefore, Applicant asserts claim 10 is further patentable over the 35 U.S.C. § 103 rejection of record.

#### **IV. Conclusion**

For at least the reasons given above, Applicant submits that the pending claims distinguish over the prior art under 35 U.S.C. §§ 102 and 103. Accordingly, Applicant submits that this application is in condition for allowance.

Applicant believes no fees are due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10010566-1 from which the undersigned is authorized to draw.

Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that the attorney can be helpful in resolving any remaining issues or can otherwise be helpful in expediting prosecution of the present application.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV 629237469 US in an envelope addressed to: M/S Amendment, Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: November 21, 2005

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Respectfully submitted,

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